REMARKS

It is respectfully requested that the present application be re-examined and reconsidered in the manner provided in 37 CFR §1.112, and in the light of the following remarks.

The sole issue remaining to be resolved in the present application is the continued rejection of the claims under the first paragraph of 35 USC §112, based on the allegation that the change of units from m^{-3} to cm^{-3} constitutes an impermissible introduction of "new matter" into the present application. That rejection is again respectfully traversed, for the following reasons.

In the "Response to Arguments" section of the Official Action of December 2, 2003, the Official Action appears to misapprehend applicants' arguments of October 30, 2003, regarding the manner in which the material introduced by amendment had been incorporated by reference into the present application from the Japanese priority application.

In particular, the Official Action contends that "[s]imply claiming foreign priority to a foreign patent doesn't automatically incorporate that foreign patent." However, that was not the nature of applicants' argument. In support of this point, we note that the claim to foreign priority was made subsequent to filing of the present application, by way of the

latter claiming foreign priority filed April 10, 2001. Applicants do not at present contend that the claim of foreign priority filed April 10, 2001 served to incorporate by reference the entirety of Japanese Application No. 2000-085198 (although it certainly would be within the Director's discretion to accept such priority claim as an incorporation by reference of the priority document).

Applicants' argument instead relied upon the separate statement on the transmittal letter, filed simultaneously with and forming a part of the present application on March 26, 2001, to the effect that the present application is one "corresponding to Japanese Appln. 2000-085198, filed March 24, 2000." (emphasis added). The latter statement is significantly different than a mere claim to the priority of the Japanese application.

In particular, that statement could not be accurate if the typographical error expressing units in m^{-3} were viewed literally, without the appreciation of one skilled in the art and outside the context of the evidence of record establishing that the existence in nature of the error would have been readily appreciated. In particular, an application describing for the first time an impurity concentration value six orders of magnitude lower than the value described in the priority application, could not under any appropriate analysis be said to "correspond" to that priority application.

Therefore, either the units of m^{-3} are incorrect (which is plainly the case), or the statement that the present application "corresponds to" the priority application is incorrect. The Official Action provides no basis for rejecting the disclosure that the present application corresponds to the priority application, in favor of accepting the obviously incorrect expression of units.

We note in this regard that this statement in the transmittal letter of the present application is not argued as necessarily incorporating the entirety of the priority application, but rather only those portions which, if not incorporated, would cause the present application not to "correspond to" the priority application. In this case, the statement plainly serves to incorporate by reference at least that portion of the priority application supporting the correction of the units in question.

The concluding paragraph on page 2 of the Official Action sets forth a requirement that applicant amend the present disclosure to include the material incorporate by reference. In response, applicants note that this has been done, by the previous amendment that corrects the units in question. That paragraph also sets forth the requirement that the amendment be accompanied by an affidavit or declaration executed by the applicant or a practitioner representing the applicant, stating

that the amendatory material consists of the same material incorporated by reference in the referencing application. In response to that requirement, applicants hereby represent that the correction of units in question is indeed supported by the priority application.

The Official Action also contended that, even if the foreign priority application had been incorporated by reference, the reference still recites both types of units (m^{-3} and cm^{-3}). However, a review of the priority application indicates that this is not the case. No units of m^{-3} are found therein.

The above discussion is believed to demonstrate that the foreign priority application must be regarded as having been incorporated by reference into the present application, at least to the extent necessary to support the correction of the obvious typographical error of m^{-3} to the obviously correct units of cm^{-3}. Again, we note in this regard that the Patent Office has been held to have considerable discretion in determining what may or may not be incorporated by reference in a patent application (*General Electric Co. v. Brenner*, 407 F.2d 1258, 159 USPQ 335 (DC Cir. 1968)), and that the facts of the present application clearly recommend exercising that discretion in favor of permitting the corrections made herein.

Applicants also note that the above discussion regarding incorporation by reference is by no means the only

basis for accepting the correction of units in the present application, as has been discussed previously. In particular, the standard set forth in *In re Oda*, 443 F.2d 1200, 170 USPQ 260 (CCPA 1971) directs that, quite apart from any consideration of incorporation by reference, correction of a typographical error in a patent application to the disclosure correctly appearing in a priority application will not constitute new matter if the skilled artisan (1) would have recognized that the original disclosure was mistaken, and (2) would have known what the correct disclosure should have been. The evidence of record clearly establishes that both of those criteria are satisfied for the correction in question, and the Office in this case has challenged neither the correctness of that legal standard, nor the adequacy of the evidentiary basis showing that such standard has been satisfied. Applicants refer in this regard to the detailed evidentiary bases set forth in the Supplemental Amendment After Final Rejection filed May 28, 2003, none of which bases have been refuted.

Applicants furthermore note that, as discussed in the Amendment After Final Rejection filed April 28, 2003, the discussion of JP10-12969 appearing on page 8, lines 11-16 of the original specification, characterizes this prior art reference as disclosing an impurity concentration in atoms per cubic meter (m^{-3}). As shown in the copy of that prior art reference

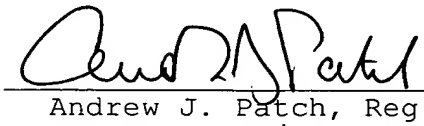
accompanying the response of April 28, 2003, the reference actually describes the impurity concentration in atoms per cubic centimeter (cm^{-3}). Therefore, even discounting the appreciation of those skilled in the art that the m^{-3} units are obviously incorrect and must instead be cm^{-3}, the specification itself makes manifest that the units are expressed in error and should instead be the corrected value, by making the error consistently not only with respect to the invention disclosed therein, but also with respect to the prior art discussed therein. Therefore, the publicly available prior art document discussed in the specification independently establishes that the *Oda* criteria are satisfied in this case, such that the correction of the obvious typographical error plainly should be permitted.

In light of the above discussion, therefore, it is believed that the correction of units has been adequately demonstrated not to constitute new matter, and that the rejection of the claims under the first paragraph of 35 USC §112 on that basis should be withdrawn, and the present application allowed. Withdrawal of the rejection and allowance and passage to issue

of the present application are accordingly respectfully requested.

Respectfully submitted,

YOUNG & THOMPSON



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June 2, 2004